

REMARKS/ARGUMENTS

Claims 1-78 were pending in the application of which claims 1, 30, 40, and 67 were independent claims. Claims 40-66 have been previously withdrawn. Applicants note that this and the previous Action indicate that claims 1-77 were pending; however, Applicants submits new claims 67-78 via preliminary amendment on April 5, 2006. Claims 1, 2, and 67 have been amended above. The amended claims are fully supported by the specification and add no new subject matter. Claims 30-39 and 70 have been canceled. Accordingly, claims 1-29, 67-69 and 71-78 are still pending of which claims 1 and 67 are independent claims.

Amendments to the Specification:

Applicants have added several paragraphs related to the addition of figures 15-18 described below. Since these figures and a detailed description thereof were incorporated by reference from the original specification as filed, Applicants believe the added paragraphs are fully supported by the original specification as filed and that no new matter has been added by the addition of these paragraphs.

Amendments to the Drawings:

Applicants have added drawings 5-8 from the parent application, which were incorporated by reference in the original specification for this application, as new figures 15-18. Accordingly, Applicants believe that the additional drawings are supported by the specification as originally filed and do not introduce new matter.

Objections to the specification:

Paragraph 2a objects to the specification under 37 C.F.R. 1.71 for allegedly failing to disclose in paragraph 26 how one of skill in the art would evaluate and correct the swing technique of a golfer. Applicants point out that paragraph 26 provides an overview of the more detailed processes described in the remainder of the detailed description. For example, the description of steps 102-106 detail how a golfer can be interviewed to determine information related to the golfer's game, skill level, swing, etc., and how this information can be combined with an evaluation of the golfer's current equipment and swing in order to identify more obvious swing flaws. The detailed description goes on to explain that these obvious swing flaws can be corrected before proceeding. (See paragraph 30).

Further, paragraph 33 indicates that after performing steps 108-112 it may be necessary to provide instruction to help the golfer develop a more efficient swing. One of skill in the art will understand that there are certain obvious swing flaws and that any of numerous tried and true approaches to correcting them can be used to improve or eliminate such flaws. Moreover, one of skill in the art will understand that a more efficient swing means a swing that delivers more energy to the golf ball. Thus, any technique that results in the delivery of more energy to the golf ball, e.g., such as eliminating an early release or increasing load on the shaft, can be used in conjunction with the systems and methods described in the application.

Paragraph 2b objects to the specification under 37 C.F.R. 1.71 for allegedly failing to disclose how one of skill in the art is to specify optimum golf equipment. Applicants respectfully disagree as the entire specification is directed to detailed systems and methods designed to determine specific equipment combinations that produce

optimum results for a particular golfer. One of skill in the art will understand after reading the specification that once a certain combination of equipment had been identified, then that equipment can be specified for the golfer.

Accordingly, Applicants respectfully request withdrawal of the objections of paragraph 2.

Objections to the Drawings:

Paragraph 1 of the Action objects the drawings under 37 C.F.R. 1.83(a) alleging that the figures do not show the configurable weights for a head of claim 73 and the quick disconnect of claims 67-77. Applicants have added claims 15-18, and an accompanying description, which clearly show example embodiments of the identified features. Figures 15-18 reproduce figures 5-8 from the parent application, which was incorporated by reference in the original specification. Accordingly, Applicants respectfully request withdrawal of the objection.

Claim Rejections Under § 112:

Paragraph 4 of the Action rejects claims 1-39 and 67-77 as under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the written description requirement.” Applicants traverse the rejection because the Application clearly provides adequate written description in support of the claims.

MPEP § 2163 (III)(A) states, “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *See, e.g., In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Further, the Examiner has the initial burden of presenting

by a preponderance of evidence why a person skilled in the art would not recognize in an Applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97."

MPEP §2163 continues stating, "In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should: (A) Identify the claim limitation at issue; and (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description." Furthermore, there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. (*Wertheim*, 541 F.2d at 262.) Consequently, rejection of an original claim for lack of written description should be rare. (MPEP § 2163.03).

With respect to claims 1-29, the Action repeats the objection stated in paragraph 2a. Applicants traverse this rejection for the same reasons, i.e., one of skill in the art would understand after reading Applicants specification how to determine whether a golfer swing needs to modify. More specifically, the description of figure 2 explains in detail how an evaluation of such things as load time and load pattern can indicate whether the golfer's swing needs to be modified.

With respect to claims 1-39 and 73-75, as well as 67-77 the Action states that it is uncertain how to specify golf equipment as claimed in the claims. Applicants respectfully disagree. The entire specification is replete with descriptions of the various

parameters for all parts of the golf club that can be changed to produce an optimum ball flight. Clearly, specifying golf equipment then involves no more than specifying the parameters that produced the optimum ball flight.

Accordingly, Applicants respectfully submit that claims 1-39 and 67-77 meet the requirements of 35 USC §112, first paragraph and respectfully requests withdrawal of the rejection.

Paragraph 6 of the Action rejects claims 2-4 under U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Although, the Applicants believe that the original pending claims were sufficiently definite, the Applicants have amended claim 2 to further define the Applicants' claimed invention.

For at least the above reasons, Applicants believe that claims 2-4 are definite. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-4.

Claim Rejections Under § 103:

Paragraph 8 of the Action rejects claims 1,5, and 28-29 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson (U.S. Patent Publication 2003/0008731) in view of Gobush (U.S. Patent No. 6,758,759) in further view of Cervantes (U.S. Patent No. 5,779,556). Applicants respectfully traverse the rejection because Anderson in further view of Pelz and Cervantes fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Anderson and Pelz alone or in combination, fail to teach each and every element of the claims as amended.

For example, certain embodiments of the present application are directed to a method for fitting a golfer with a golf club in which a baseline configuration of club head, shaft, grip, and ball are used and the results of using the baseline configuration are monitored. (See, e.g., the description of figure 2 in the present application). In particular, swing data such as a load time and load pattern can be used to select, e.g., a shaft flex for the baseline configuration. (See, e.g., see paragraph [0045]). The monitoring can include monitoring of launch information such as launch angle, velocity and spin. (See, e.g., paragraph [0052]). The monitored information can then be used to select at least one of a new golf shaft or club head in order to optimize the velocity, spin, and launch angle relative to each other. (See, e.g., paragraphs [0052]-[0056]).

This optimization can include optimizing the velocity based on the launch angle and/or spin rate. (See description of figure 3). Thus, claim 1 as amended is directed to a method of fitting a golfer with a golf club in which a baseline club configuration comprising a baseline shaft flex is used to launch a golf ball. The resulting launch

parameters are used to monitor “how the golfer launches a golf ball using a golf club comprising a shaft characterized by the specified shaft flex to obtain launch data including a launch angle, velocity and speed; and modifying the golf club characteristics based on the launch data to optimize a launch angle, velocity and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate.”

Conversely, Anderson, Gobush and Cervantes, alone or in combination, fail to teach such optimization. Accordingly, Applicants believe that claim 1 as amended is allowable over the art of record. Claims 5 and 28-29 depend from claim 1 are therefore allowable for at least the same reasons as claim 17. Applicants therefore respectfully request withdrawal of the rejection of claims 1, 5, and 28-29.

Paragraph 9 of the Action rejects claim 2 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers (U.S. Patent No. 4,059,270). Applicants traverse this rejection because claim 2 ultimately depends from amended claim 1 and is therefore allowable for at least the same reasons as amended claim 1, unless Sayers makes up for the deficiencies of Anderson, Gobush and Cervantes which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 2.

Paragraph 10 of the Action rejects claims 3-4 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers in still further view of Nauck (U.S. Patent No. 5,616,832) in still further view of Naruo (U.S. Patent No. 5,812,417). Applicants traverse this rejection because claims 3 and 4 ultimately depend from amended claim 1 and are therefore allowable for at least the same reasons as amended claim 1, unless Sayers, Nauck and

Naruo make up for the deficiencies of Anderson, Gobush and Cervantes which they do not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 3-4.

Paragraph 11 of the Action rejects claims 6-9 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers in still further view of Naruo. Applicants traverse this rejection because claims 6-9 ultimately depend from amended claim 1 and are therefore allowable for at least the same reasons as amended claim 1, unless Naruo makes up for the deficiencies of Anderson, Gobush and Cervantes which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 6-9.

Paragraph 12 of the Action rejects claims 10-27 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Examiner's Official Notice. Applicants traverse this rejection because claims 10-27 ultimately depend from amended claim 1 and are therefore allowable for at least the same reasons as amended claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 10-27.

Paragraph 13 of the Office Action rejects claim 30 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson in view of Pelz (U.S. Patent No. 5,039,098). Applicants respectfully traverse the rejection because claim 30 has been cancelled thereby rendering the rejection moot. Applicants therefore respectfully request withdrawal of the rejection of claim 30; however, Applicants expressly reserve the right to pursue any patentable material included in claim 30 at a later time.

Paragraph 14 of the Office Action rejects claims 31-39 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson in view of Pelz in further view of the Examiner's Official Notice. Applicants respectfully traverse the rejection because claims 31-39 has been cancelled thereby rendering the rejection moot. Applicants therefore respectfully request withdrawal of the rejection of claims 31-39; however, Applicants expressly reserve the right to pursue any patentable material included in claims 31-39 at a later time.

Paragraph 15 of the Office Action rejects claims 67-69 and 78 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson (U.S. Patent Publication 2003/0008731) in view of Pelz (U.S. Patent No. 5,039,098). Applicants respectfully traverse the rejection because Anderson in further view of Pelz fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this

case, the rejection must fail because Anderson and Pelz alone or in combination, fail to teach each and every element of the claims as amended.

For example, certain embodiments of the present application are directed to a method for fitting a golfer with a golf club in which a baseline configuration of club head, shaft, grip, and ball are used and the results of using the baseline configuration are monitored. (See, e.g., the description of figure 2 in the present application). The monitoring can include monitoring of launch information such as launch angle, velocity and spin. (See, e.g., paragraph [0052]). The monitored information can then be used to select at least one of a new golf shaft or club head in order to optimize the velocity, spin, and launch angle relative to each other. (See, e.g., paragraphs [0052]-[0056]).

This optimization can include optimizing the velocity based on the launch angle and/or spin rate. (See description of figure 3). Thus, claim 67 as amended is directed to a method of fitting a golfer with a golf club in which a baseline club configuration is used and the resulting launch parameters are monitored to determine how the golfer launches a golf ball using the new golf club “wherein monitoring how the golf club launches a golf ball comprises monitoring the spin, velocity, and launch angle imparted to the golf ball by the golfer using the golf club, the new golf club head or golf club shaft being selected based on the monitoring in order to optimize a launch angle, velocity and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate.”

Conversely, neither Anderson nor Pelz, alone or in combination, teach such optimization. Accordingly, Applicants believe that claim 67 as amended is allowable over the art of record. Claims 68-69, and 70 depend from claim 67 are therefore

allowable for at least the same reasons as claim 67. Applicants therefore respectfully request withdrawal of the rejection of claims 67-69 and 78.

Paragraph 16 of the Action rejects claims 70-72 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Pelz in further view of Gobush (U.S. Patent No. 6,758,759). With respect to claim 70 Applicants respectfully traverse the rejection because claim 70 has been cancelled thereby rendering the rejection moot. Applicants therefore respectfully request withdrawal of the rejection of claim 70; however, Applicants expressly reserve the right to pursue any patentable material included in claim 70 at a later time. With respect to claims 71 and 72, Applicants traverse this rejection because claims 71 and 72 ultimately depend from amended claim 67 and are therefore allowable for at least the same reasons as amended claim 67, unless Gobush makes up for the deficiencies of Anderson and Pelz which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 71 and 72.

Paragraph 17 of the Action rejects claim 73 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Pelz in further view of Holls (U.S. Patent No. 3,556,533). Applicants traverse this rejection because claim 73 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67, unless Holls makes up for the deficiencies of Anderson and Pelz which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 73.

Paragraph 18 of the Action rejects claim 74 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Pelz in further view of Examiner Official

Notice. Applicants traverse this rejection because claim 74 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 74.

Paragraph 19 of the Action rejects claim 75 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Pelz in further view of Naruo (U.S. Patent No. 5,821,417) in further view of Examiner Official Notice. Applicants traverse this rejection because claim 75 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67, unless Nauro makes up for the deficiencies of Anderson and Pelz which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 75.

Paragraph 20 of the Action rejects claims 67-69 and 76-77 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Ashcraft (U.S. Patent No. 5,513,844). Applicants respectfully traverse the rejection because Anderson in further view of Ashcraft fails to make out a *prima facie* case of obviousness fro the same reasons that Anderson and Pelz fail to make out a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 67-69 and 76-77.

Nothing in this response should be viewed as Applicants agreeing with the Examiner's Official Notice.

CONCLUSION

Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested. Applicants believe that no additional fees are necessitated by this response. The Commissioner is hereby authorized to charge any additional fees required by this response to our Deposit Account No. 13-0480 (Attorney Docket No. 67175523-001102).

Respectfully Submitted,

Date: February 15, 2008

By: /NoelCGillespie/

Noel C. Gillespie, Reg. No. 47,596
Baker & McKenzie LLP
2001 Ross Avenue, Suite 2300
Dallas, TX 75201
Telephone: (858) 523-6231
Facsimile (214) 978-3099